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**REMARKS**

This is a full and timely response to the outstanding Office action mailed February 1, 2006. Upon entry of the amendments in this response claims 1, 2, 4-21, and 23-28 are pending. More specifically, claims 18 and 19 are amended. These amendments are specifically described hereinafter.

**I. Present Status of Patent Application**

Claims 1, 2, 4-21, and 23-28 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Belissent* (U.S. Patent No. 6,865,594) in view of *Cortright* (U.S. Patent No. 6,895,426). To the extent that these rejections have not been rendered moot by the cancellation of claims, they are respectfully traversed.

**II. Rejections Under 35 U.S.C. §103(a)****A. Claims 1, 2, and 4-7**

The Office Action rejects claims 1, 2, and 4-7 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Belissent* (U.S. Patent No. 6,865,594) in view of *Cortright* (U.S. Patent No. 6,895,426). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 1 recites:**

1. A method of providing a system for automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:
  - creating an incoming domain name list in a memory;
  - receiving an incoming email communication;
  - extracting a domain name from a sender's email address from the incoming email communication;
  - storing the domain name in the incoming domain name list in the memory;

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checking if a domain name of an e-mail address associated with an intended recipient of an outgoing e-mail communication is included in the incoming domain name list in the memory; and transmitting the outgoing email communication if the domain name is included in the incoming domain name list, or *otherwise generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication.*

(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that the combination of *Belissent* and *Cortright* does not disclose, teach, or suggest at least ***otherwise generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail.*** The Office Action cites *Cortright*, col. 10, lines 20-26 as allegedly disclosing this feature: "if an address is not unique or there is more than one address for a contact, the address may be marked with a 'need more info' icon. The user may then be prompted to choose which person or address is correct and the address text is marked with an appropriate icon."

Even if *Cortright* teaches prompting when there is more than one address for a contact, it fails to disclose prompting when the domain name is not included in the incoming domain list. Therefore, *Cortright* does not disclose all the features of the instant claim. *Belissent* does not cure this deficiency.

As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 1, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 1 is allowable.

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Because independent claim 1 is allowable over the cited references of record, dependent claims 2 and 4-7 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2 and 4-7 contain all the steps of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 2 and 4-7 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2 and 4-7 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 2 and 4-7 are allowable.

**B. Claims 8-17**

The Office Action rejects claims 8-17 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Belissent* (U.S. Patent No. 6,865,594) in view of *Cortright* (U.S. Patent No. 6,895,426). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 8 recites:**

8. A method of automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:

- receiving email communications incoming to the email communications server;
- creating a domain name database;
- extracting domain names in sender's e-mail addresses from the e-mail communications incoming to the email communications server;
- storing extracted domain names in the domain name database;

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receiving outgoing e-mail communications from client computers connected to the e-mail communications server through a local network; searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of the outgoing e-mail communication provided in the outgoing e-mail communications; and ***generating an error prompt upon detecting that a domain name in an e-mail address provided in an outgoing e-mail communication is misspelled.***

(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all steps of the claim at issue. Applicant respectfully submits that independent claim 8 is allowable for at least the reason that the combination of *Belissent* and *Cortright* does not disclose, teach, or suggest at least **generating an error prompt upon detecting that a domain name in an e-mail address provided in an outgoing e-mail communication is misspelled.** The Office Action cites *Cortright*, col. 10, lines 20-26 as allegedly disclosing this feature: "if an address is not unique or there is more than one address for a contact, the address may be marked with a 'need more info' icon. The user may then be prompted to choose which person or address is correct and the address text is marked with an appropriate icon."

Even if *Cortright* teaches prompting when there is more than one address for a contact, it fails to disclose prompting when the domain name is misspelled. Therefore, *Cortright* does not disclose all the features of the instant claim. *Belissent* does not cure this deficiency.

As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 8, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 8 is allowable.

Because independent claim 8 is allowable over the cited references of record, dependent claims 9-17 (which depend from independent claim 8) are allowable as a matter of law for at

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least the reason that dependent claims 9-17 contain all the steps of independent claim 8.

Therefore, the rejection to claims 9-17 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 8, dependent claims 9-17 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 9-17 are allowable.

Regarding claims 15, 16, and 17, the Office Action alleges that storing tally information in relation to a domain name database is an inherent feature of a domain list or a contact database. However, "[a]nticipation by inherency requires that 1) the missing descriptive matter be 'necessarily present' in the prior art reference ..." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). Applicant respectfully submits that it is not necessary to keep a tally in the domain list or the contact database, and, therefore, the tally is not an inherent feature. Applicant respectfully submits that features that the Office Action concludes as inherent are not necessarily present in the prior art reference and are, in fact, not inherent.

C. Claims 18-20

The Office Action rejects claims 18-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Belissent* (U.S. Patent No. 6,865,594) in view of *Cortright* (U.S. Patent No. 6,895,426). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 18** as amended recites:

18. An e-mail server for automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:

- an interceptor for extracting domain names from e-mail addresses provided in incoming and outgoing e-mail communications;
- a database generator for generating a domain name database for storing domain names extracted from sender's e-mail addresses in incoming e-mail communications; and

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a checker for searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of in the outgoing e-mail communications,

***wherein the e-mail server prompts the user when it detects misspelled domain names in e-mail addresses in outgoing e-mail communications.***

(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all features of the claim at issue. Applicant respectfully submits that independent claim 18 is allowable for at least the reason that the combination of *Belissent* and *Cortright* does not disclose, teach, or suggest at least **wherein the e-mail server prompts the user when it detects misspelled domain names in e-mail addresses in outgoing e-mail communications**. The Office Action cites *Cortright*, col. 10, lines 20-26 as allegedly disclosing this feature: "if an address is not unique or there is more than one address for a contact, the address may be marked with a 'need more info' icon. The user may then be prompted to choose which person or address is correct and the address text is marked with an appropriate icon."

Even if *Cortright* teaches prompting when there is more than one address for a contact, it fails to disclose prompting when the domain name is misspelled. Therefore, *Cortright* does not disclose all the features of the instant claim. *Belissent* does not cure this deficiency.

As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 18, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 18 is allowable.

Because independent claim 18 is allowable over the cited references of record, dependent claims 19 and 20 (which depend from independent claim 18) are allowable as a matter of law for at least the reason that dependent claims 19 and 20 contain all the features of independent claim 18. Therefore, the rejection to claims 19 and 20 should be withdrawn and the claims allowed.

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Additionally and notwithstanding the foregoing reasons for allowability of independent claim 18, dependent claims 19 and 20 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 19 and 20 are allowable.

**D. Claims 21 and 23-25**

The Office Action rejects claims 21 and 23-25 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Belissent* (U.S. Patent No. 6,865,594) in view of *Cortright* (U.S. Patent No. 6,895,426). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 21 recites:**

21. A method of automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:
- creating an incoming email address list in a memory;
  - receiving an incoming email communication;
  - storing, in the incoming email address list in the memory, an email address extracted from the incoming email communication;
  - checking if an e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the incoming email address list in the memory; and
  - transmitting the outgoing email communication if the e-mail address is included in the incoming email address list, or *otherwise generating a prompt for a user to confirm an e-mail address if the domain name is not included in the incoming email address list.*

(Emphasis added).

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For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all steps of the claim at issue. Applicant respectfully submits that independent claim 21 is allowable for at least the reason that the combination of *Belissent* and *Cortright* does not disclose, teach, or suggest at least **otherwise generating a prompt for a user to confirm an e-mail address if the domain name is not included in the incoming email address list**. The Office Action cites *Cortright*, col. 10, lines 20-26 as allegedly disclosing this feature: "if an address is not unique or there is more than one address for a contact, the address may be marked with a 'need more info' icon. The user may then be prompted to choose which person or address is correct and the address text is marked with an appropriate icon."

Even if *Cortright* teaches prompting when there is more than one address for a contact, it fails to disclose prompting when the domain name is not included in the incoming domain list. Therefore, *Cortright* does not disclose all the features of the instant claim. *Belissent* does not cure this deficiency.

As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 21, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 21 is allowable.

Because independent claim 21 is allowable over the cited references of record, dependent claims 23-25 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 23-25 contain all the steps of independent claim 21. Therefore, the rejection to claims 23-25 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 23-25 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 23-25 are allowable.



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E. Claims 26-28

The Office Action rejects claims 26-28 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Belissent* (U.S. Patent No. 6,865,594) in view of *Cortright* (U.S. Patent No. 6,895,426). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 26 recites:**

26. An e-mail communications system stored in a client computer for automatically checking for incorrect e-mail addresses provided in outgoing e-mail communications from the client computer prior to transmission to an e-mail server, comprising:

- an address extractor for extracting sender's e-mail addresses from incoming e-mail communications;
- a previous sender addresses memory for storing e-mail addresses extracted from sender's e-mail addresses in incoming e-mail communications; and
- a checker for searching the previous sender addresses memory for e-mail addresses of intended recipients that are provided in outgoing e-mail communications,

***wherein the checker generates a prompt for verification of an e-mail address of an intended recipient upon detecting that an e-mail address of an intended recipient in an outgoing e-mail communication is not present in the previous sender addresses memory.***

(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all features of the claim at issue. Applicant respectfully submits that independent claim 26 is allowable for at least the reason that the combination of *Belissent* and *Cortright* does not disclose, teach, or suggest at least **wherein the checker generates a**

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**prompt for verification of an e-mail address of an intended recipient upon detecting that an e-mail address of an intended recipient in an outgoing e-mail communication is not present in the previous sender addresses memory.** The Office Action cites *Cortright*, col. 10, lines 20-26 as allegedly disclosing this feature: "if an address is not unique or there is more than one address for a contact, the address may be marked with a 'need more info' icon. The user may then be prompted to choose which person or address is correct and the address text is marked with an appropriate icon."

Even if *Cortright* teaches prompting when there is more than one address for a contact, it fails to disclose prompting when the domain name is not included in the incoming domain list. Therefore, *Cortright* does not disclose all the features of the instant claim. *Bellisent* does not cure this deficiency.

As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 26, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 26 is allowable.

Because independent claim 26 is allowable over the cited references of record, dependent claims 27 and 28 (which depend from independent claim 26) are allowable as a matter of law for at least the reason that dependent claims 27 and 28 contain all the steps/features of independent claim 26. Therefore, the rejection to claims 27 and 28 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 26, dependent claims 27 and 28 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence there are other reasons why dependent claims 27 and 28 are allowable.

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**V. Miscellaneous Issues**

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

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**CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1, 2, 4-21, and 23-28 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

  
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